Rejection of Claims 1-8 Under
Section 102(e) Based Upon Lee

In the Office Action, claims 1-8 have been rejected under 35 U.S.C. § 102(e) (hereinafter "Section 102(e)") as being anticipated by U.S. Patent No. 6,375,321 to Lee et al. (hereinafter "Lee").

The rejection of claim 1 has been rendered moot by the cancellation of claim 1. Claims 2-8 have been amended herein below to depend from claim 9, which has been rewritten in independent form and was not subject to this rejection as being anticipated by Lee. Accordingly, Applicant respectfully submits that this rejection should be withdrawn.

Rejection of Claims 1-18 Under
Section 103(a) Based Upon Zelman in view of Mauch

In the Office Action, claims 1-18 have been rejected under 35 U.S.C. § 103(a) (hereinafter "Section 103(a)") as being render unpatentable over U.S. Patent No. 6,343,858 to Zelman (hereinafter "Zelman") in view of U.S. Patent No. 6,170,949 to Mauch (hereinafter "Mauch").

Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness under Section 103(a), the rejection is misplaced, and it should be withdrawn. The Office Action fails to establish that a person of ordinary skill in the art to which the invention is directed would have found it obvious to combine the cited documents in the manner suggested by the Examiner.

It is fundamental law that it is improper under Section 103(a) to use hindsight reconstruction to pick and choose among isolated disclosure in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Teachings of references can be combined only if there is some suggestion or motivation to do so. *Smithkline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886-87 (Fed. Cir. 1988). This burden of obviousness has not been met with regard to claims 1-18, and, therefore, this rejection is traversed.

Further, it is error not to give due regard for a disclosure in an applied document that teaches away from the claimed invention. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). As the Federal Circuit stated in *Kloster Speedsteel AB v. Crucible Inc.*, 230 USPQ 81, 86 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 1034 (1987), where applied art discourages from attempting the substitution suggested by the applicant, such teachings are "strongly probative of nonobviousness". *See also Gillette Co. v. S.C. Johnson & Son, Inc.*, 16 USPQ2d 1923 (Fed. Cir. 1990). The Examiner has failed to consider Zelman in its entirety, ignoring portions of Zelman that teach away from the claimed invention and its combination with Mauch. *See, e.g., Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 230 USPQ 416, 420 (Fed. Cir. 1986).

Claims 2-9

The present invention as recited in pending independent claim 9 is not rendered obvious by Zelman and Mauch and therefore the rejection is misplaced and should be withdrawn, because Zelman and Mauch, alone or in combination, fail

to teach an eyewear assembly comprising primary eyeglasses comprising a frame including first and second recessed sockets, each provided with respective metallic, non-magnetized bottom and side walls, and auxiliary eyeglasses comprising a bridge, first and second auxiliary lens rims, and first and second arms, wherein the first and second arms each have a respective magnet permanently affixed to them, and further wherein the magnets have protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets, wherein when the primary eyeglasses are worn on the human face, the sockets each have a respective opening facing downward for receiving a corresponding one of the magnets from below, as recited in claim 9.

One of the features recited in independent claim 9 is the "catch-and-click mating engagement" feature. The magnets permanently affixed to the auxiliary eyeglass frames attract not only to the corresponding metallic bottom surfaces of the corresponding sockets of the primary frames, but also the metallic side walls of the sockets. As a consequence, a relatively large surface area is provided at which the magnets may engage or "catch" the upper edges of the corresponding stainless steel socket side walls. Once caught on the metallic side walls, the magnets may be guided in small lateral adjustments while maintaining contact against the side wall edges until the magnets are received into the sockets. The reception of the magnets into their corresponding sockets provides a clicking engagement, which indicates to

the wearer that the auxiliary eyeglasses are fully engaged and mated with the primary eyeglasses.

Zelman teaches away from the catch-and-click engagement. Zelman discloses an apparatus comprising a plurality of sockets formed on temple extensions of the conventional eyeglasses, and a plurality of sockets formed on appendages on the auxiliary sunglasses. The appendages fit below the temple extensions. A plurality of magnets is mounted in the sockets of the conventional eyeglasses, and another plurality of magnets is mounted in the plurality of sockets on the appendages. A first pair of the sockets has its magnets mounted to form recesses in the sockets. The second pair of sockets has its magnets extending out of the sockets so as to fit into the recesses of the first pair of sockets.

According to Zelman, the "magnets have a very strong attraction in a direction perpendicular to their axis." (Col. 3, lines 3-4.) Each of the magnets has a respective pole that exerts a magnetic force. (Col. 3, lines 8-17.) The plurality of magnets mounted on the conventional eyeglasses and the plurality of magnets mounted on the auxiliary eyeglasses are oriented such that the maximum magnetic attractive force between the magnets is asserted along their respective axes, approximately parallel to lenses in the conventional eyeglasses. The exertion of this magnetic attractive force is characterizes as a "key feature" of the invention. (Col. 7, lines 44-50.)

According to Zelman, the extended magnets in the second pair of sockets engage the recesses to *automatically align and secure* the auxiliary eyeglasses when

engaged with the magnets forming the recesses in the first pair of sockets to provide maximum resistance to downward movement of said auxiliary eyeglasses.

> One can easily see the auxiliary eyeglasses approaching the conventional eyeglasses with the appendages on the auxiliary eyeglasses below the temple of the conventional eyeglass frame. Then with a very slight upward movement the magnets attract and the auxiliary eyeglass frame is firmly attached. This can be done simply and easily with one hand *without any feeling or fumbling that previous arrangements required. The orientation is nearly automatic and doesn't require the more careful alignment that is required of other magnetically fastened auxiliary eyeglasses.*
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> The unique and distinct advantage of the invention is the avoidance of scratching the lenses with the appendages for holding the magnet sockets. The reason for this is that the auxiliary eyeglasses are mounted from below. With the recessed sockets a more firm attachment is achieved and alignment of the auxiliary eyeglass frames on the conventional eyeglass frames is almost automatic. One need only press the auxiliary eyeglass lenses against the conventional eyeglass lenses and with a slight upward movement, *the raised magnets on one side almost automatically slip into and seat in the recess in the complementary socket*. The raised and recessed magnets provide automatic alignment and additional support against horizontal movement of the auxiliary eyeglass.

Zelman, column 3, lines 42-51 and column 3, line 64 to column 4, line 11 (emphasis added).

As described in Zelman, when the auxiliary frames are pressed against the conventional frames, the user need only apply "a slight upward movement" to the auxiliary frames to cause the raised magnets to "automatically slip into and seat in the recess of the complementary socket[s]," thereby automatically aligning the conventional and auxiliary frames. Horizontal shifting of the auxiliary frames in a transverse direction to the poles, *i.e.*, non-upward movement, is not required and is

not part of the automatic alignment. Zelman characterizes the automatic alignment feature as a "unique and important improvement."

The Examiner attempts to modify Zelman by substituting one of Zelman's pairs of permanent magnets for the "ferrous material" disclosed in Mauch. However, this modification would contradict the objects of Zelman and defeat a "key feature" of Zelman. Specifically, the modification suggested by the Examiner would destroy the automatic alignment feature of Zelman. The permanent magnets of the resultant modified assembly would attract not only to the metallic bottom surface of the corresponding sockets of the primary frames, but also the metallic side walls of the sockets. As a consequence, the magnets would engage or "catch" the upper edges of the corresponding metallic socket side walls. When caught on the metallic side walls, the magnets are not automatically aligned with their corresponding sockets. Instead, the magnets must be translated in small lateral adjustments while maintaining contact against the side wall edges until the magnets are received into the sockets. Thus, full alignment and engagement of the extended magnets into their respective sockets would require that the magnets of the auxiliary eyewear be manipulated by more than a simple upward movement to place the magnets in alignment with the stainless steel sockets. This lateral movement, which is characteristic of the "catch and click" feature of the claimed invention, is contradictory to the "automatically alignment" feature of Zelman. Stated differently, the catch-and-click feature of the claimed invention and method

is the type of "feeling and fumbling" movement that Zelman's automatic alignment feature was intended to avoid.

For these reasons, Applicant respectfully submits that claim 9 is patentable over Zelman and Mauch, when taken alone or in combination. Applicant further respectfully submits that claims 2-8, which depend from claim 9 and include all of the distinguishing features of claim 9, are patentable over Zelman and Mauch, alone or in combination, for the reasons advanced above. (Claim 1 has been cancelled and, therefore, its rejection rendered moot.)

Claims 10-18

Zelman and Mauch do not render claim 10 of the present application obvious because Zelman and Mauch, when taken alone or in combination, fail to disclose an eyewear assembly comprising primary eyeglasses comprising a frame including first and second magnets, and auxiliary eyeglasses comprising a bridge, first and second auxiliary lens rims, and first and second arms, wherein each of the first and second arms have a recessed socket, and wherein each of the sockets is provided with a metallic, non-magnetized bottom and side walls, and wherein the magnets have protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets, as recited in claim 10.

Like claim 9, claim 10 recites a eyewear assembly characterized by a catch-and-click mating engagement feature. As explained in detail above with regard to

claims 2-9, a person having ordinary skill in the art at the time the invention was made would not have been motivated to modify Zelman to include this catch-and-click mating engagement feature. Such modification would have defeated express objects of Zelman and would have been contradictory to key features of Zelman. Mauch does not provide adequate motivational teaches to have persuaded a person of ordinary skill in the art to not only ignore, but also to contradict the teachings of Zelman.

For these reasons, Applicant respectfully requests reconsideration and withdrawal of the Section 103(a) rejection of claim 10 and claims 11-18, which depend therefrom.

Conclusion

In view of the foregoing, Applicant submits that the pending claims are allowable and that the application is in condition for allowance. Reconsideration of the application in view of this Response and its passage to issue are respectfully requested.

If, after reviewing the above, the Examiner believes any issues remain unresolved, the favor of an Examiner interview is requested and the Examiner is requested to contact the undersigned, by telephone, to schedule such interview.

IN THE CLAIMS:

Please cancel claim 1 without prejudice or disclaimer.

Please amend claims 2-9 to read as follows:

2. (Once amended) The eyewear assembly of claim 9, wherein the first and second lateral temple mounts have respective lobes containing the first and second sockets, respectively.

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3. (Once amended) The eyewear assembly of claim 9, further comprising first and second earpieces covering distal portions of the first and second temples, respectively.

4. (Once amended) The eyewear assembly of claim 9, wherein the metallic, non-magnetized bottom and side walls define a cup.

5. (Once amended) The eyewear assembly of claim 9, wherein the metallic, non-magnetized side walls have a circular cross section.

6. (Once amended) The eyewear assembly of claim 9, wherein the metallic, non-magnetized bottom and side walls are paramagnetic.

7. (Once amended) The eyewear assembly of claim 9, wherein the metallic, non-magnetized bottom and side walls comprise stainless steel.

8. (Once amended) The eyewear assembly of claim 9, wherein the first and second temples are pivotally connected to the first and second lateral temple mounts.

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9. (Once amended) A eyewear assembly sized and configured for wearing on a human face and comprising primary eyeglasses and auxiliary eyeglasses that are attachable by catch-and-click mating engagement and detachable from each other,

the primary eyeglasses comprising:

a frame comprising a bridge, first and second lens rims connected by the bridge, and first and second temple mounts on opposite sides of the frame and attached to the first and second lens rims, respectively, the frame including first and second recessed sockets each provided with respective metallic, non-magnetized bottom and side walls, the side walls being oriented substantially vertical when the primary eyeglasses are worn on the human face;

first and second temples mounted to the first and second temple mounts, respectively; and

first and second lenses mounted to the first and second lens rims; and

the auxiliary eyeglasses comprising:

an auxiliary frame comprising an auxiliary bridge, first and second auxiliary lens rims connected by the auxiliary bridge, and first and second arms connected to the first and second auxiliary lens rims, respectively, the first and second arms each having a respective magnet permanently affixed thereto, the magnets having protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets; and

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first and second auxiliary lenses mounted to the first and second auxiliary lens rims, respectively,

wherein when the primary eyeglasses are worn on the human face, the sockets each have a respective opening facing downward for receiving a corresponding one of the magnets from below.

IN THE CLAIMS:

Please cancel claim 1 without prejudice or disclaimer.

Please amend claims 2-9 as follows:

2. (Once amended) The eyewear assembly of claim [1] 9, wherein the first and second lateral temple mounts have respective lobes containing the first and second sockets, respectively.

3. (Once amended) The eyewear assembly of claim [1] 9, further comprising first and second earpieces covering distal portions of the first and second temples, respectively.

4. (Once amended) The eyewear assembly of claim [1] 9, wherein the metallic, non-magnetized bottom and side walls define a cup.

5. (Once amended) The eyewear assembly of claim [1] 9, wherein the metallic, non-magnetized side walls have a circular cross section.

6. (Once amended) The eyewear assembly of claim [1] 9, wherein the metallic, non-magnetized bottom and side walls are paramagnetic.

7. (Once amended) The eyewear assembly of claim [1] 9, wherein the metallic, non-magnetized bottom and side walls comprise stainless steel.

8. (Once amended) The eyewear assembly of claim [1] 9, wherein the first and second temples are pivotally connected to the first and second lateral temple mounts.

9. (Once amended) A [The] eyewear assembly [of claim 1] sized and configured for wearing on a human face and comprising primary eyeglasses and auxiliary eyeglasses that are attachable by catch-and-click mating engagement and detachable from each other,

the primary eyeglasses comprising:

a frame comprising a bridge, first and second lens rims connected by the bridge, and first and second temple mounts on opposite sides of the frame and attached to the first and second lens rims, respectively, the frame including first and second recessed sockets each provided with respective metallic, non-magnetized bottom and side walls, the side walls being oriented substantially vertical when the primary eyeglasses are worn on the human face;

first and second temples mounted to the first and second temple mounts, respectively; and

first and second lenses mounted to the first and second lens rims; and

the auxiliary eyeglasses comprising:

an auxiliary frame comprising an auxiliary bridge, first and second auxiliary lens rims connected by the auxiliary bridge, and first and second arms connected to the first and second auxiliary lens rims, respectively, the first and second arms each having a respective magnet permanently affixed thereto, the magnets having protruding portions sized and configured to be received into corresponding ones of the sockets and to magnetically attract the metallic, non-magnetized bottom and side walls of the sockets to permit catch-and-click mating engagement of the magnets with the sockets; and

first and second auxiliary lenses mounted to the first and second auxiliary lens rims, respectively,

wherein when the primary eyeglasses are worn on the human face, the sockets each have a respective opening facing downward for receiving a corresponding one of the magnets from below.

Applicant respectfully petitions for an extension of time. The Commissioner is authorized to charge a one-month extension fee to our Deposit Account No. 501324 under Order No. 1120-004. If any fees are missing or deficient, please charge our Deposit Account No. 501324.

Dated: January 13, 2003

Respectfully submitted,

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CERTIFICATE OF EXPRESS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service on January 13, 2003 with sufficient postage as first class mail in an envelope addressed the Assistant Commissioner for Patents, U.S. Patent & Trademark Office, Washington, D.C. 20231.